

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated July 18, 2006 (hereinafter Office Action) have been considered. Claims 1-66 remain pending in the application. Applicant appreciates the Examiner's conscientious review and consideration of Applicant's remarks presented in the previous responsive communication.

Claims 1-2, 4-5, 9, 16-19, 21-22, 31-34, 46-49, 53-56, 58 and 65-66 stand rejected based on 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,178,349 to *Kieval*.

Kieval teaches an implantable nerve stimulator. (Col. 2, Lines 57-59). The embodiments disclosed by *Kieval* include only stimulating nerves that communicate with the brain and/or brain stem. (Col. 5, Lines 3-27). *Kieval* states that the disclosed nerve stimulation only indirectly influences organs (except for the brain) because the stimulated nerves relay to nerve centers, such as the brain, where the stimulated nerve center can then reflexively change organ function. (Col. 4, Lines 33-48). With respect to the heart, *Kieval* states that "[s]elective stimulation of the right or left vagus nerves 44, 46 may bring into control the heart rate and blood flow without resorting to direct stimulation of the heart 22" (Col. 4, Lines 33-36; emphasis added). However, each of Applicant's independent claims recite some variation of a cardiac electrode configured for one or both of cardiac monitoring and cardiac electrical stimulation, which is clearly not disclosed in *Kieval*.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicant respectfully submits that *Kieval* does not teach each and every element of independent claims 1, 18, 33, 48 and 55, and therefore fails to anticipate these claims.

Dependent claims 2, 4-5, 9, 16-17, 19, 21-22, 31-32, 34, 46-47, 49, 53-54, 56, 58 and 65-66, which are dependent from independent claims 1, 18, 33, 48 and 55, respectively, were also rejected under 35 U.S.C. §102(b) as being unpatentable over *Kieval*. While

Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1, 18, 33, 48 and 55. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 2, 4-5, 9, 16-17, 19, 21-22, 31-32, 34, 46-47, 49, 53-54, 56, 58 and 65-66 are also not anticipated by *Kieval*.

As such, Applicant respectfully requests withdrawal of the §102(b) rejection of claims 1-2, 4-5, 9, 16-19, 21-22, 31-34, 46-49, 53-56, 58 and 65-66 and notification that these claims are in condition for allowance.

Claims 3, 6-8, 10-15, 25-26, 29-30, 35-42, 44-45, 50-52, 57 and 63-64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Kieval* in view of U.S. Patent No. 5,628,730 to *Shapland et al.* (hereinafter “*Shapland*”). Claims 20, 23-24, 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Kieval* in view of *Shapland*. Claim 43 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Kieval* in view of U.S. Patent No. 4,506,680 to *Stokes*. Claims 59-62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Kieval* in view of U.S. Patent No. 5,749,909 to *Schroeppel et al.* (hereinafter “*Schroeppel*”).

Three criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142.

Each of claims 3, 6-8, 10-15, 20, 23-30, 35-42, 44-45, 48, 50-52, 57 and 63-64 depend from one of independent claims 1, 18, 33, 48 and 55, respectively. Independent claims 1, 18, 33, 48 and 55 are not obvious for at least the reason that the cited references fail to teach or suggest each and every limitation recited in each claim. Furthermore, while Applicant does not acquiesce with the particular rejections to these dependent claims, it is

believed that these rejections are now moot in view of the remarks made in connection with independent claims 1, 18, 33, 48 and 55. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 3, 6-8, 10-15, 20, 23-30, 35-42, 44-45, 50-52, 57 and 63-64 are not made obvious by *Kieval*, even in combination with *Shapland*. Also, dependent claim 43 is not made obvious by *Kieval*, even in combination with *Stokes*, and dependent claims 59-62 are not made obvious by *Kieval*, even in combination with *Schroeppel*.

As such, Applicant respectfully requests withdrawal of the §103(a) rejection of claims 3, 6-8, 10-15, 20, 23-30, 35-42, 44-45, 48, 50-52, 57 and 63-64 and notification that these claims are in condition for allowance.

It is to be understood that Applicant does not acquiesce to the Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, alternative equivalent arrangements, common knowledge at the time of Applicant's invention, officially noticed facts, and the like.

Specifically, Applicant disputes that it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify a cardiac therapy system or method by utilization of at least one type of phoresis and/or a particular location of, and/or a particular coverage by, a particular agent that is influenced by phoresis, as contended by the Examiner on page 7 of the Office Action. Furthermore, Applicant disputes that the filed Application fails to disclose that modification of a cardiac therapy system or method by utilization of at least one type of phoresis and/or a particular location of, and/or a particular coverage by, a particular agent that is influenced by phoresis, is used for a particular

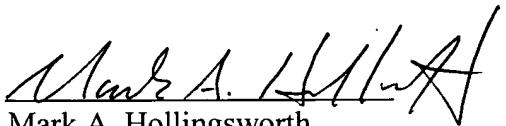
purpose, or solves a stated problem, as contended by Examiner on page 7 of the Office Action. Moreover, Applicant disputes that one of ordinary skill in the art would have expected that a lead with utilization of at least one type of phoresis and/or a particular location of, and/or a particular coverage by, a particular agent that is influenced by phoresis would have performed equally well as with the same used with a can, as contended by Examiner on page 7 of the Office Action. Finally, Applicant disputes that it would have been an obvious matter of design choice to modify *Kieval* in view of *Shapland*, as contended by Examiner on page 7 of the Office Action.

Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in Applicant's pending claims and lack of motivation to combine reference teachings. Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (GUID.626PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him to discuss any issues related to this case.

Respectfully submitted,
HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: 9-21-2006

By: 
Mark A. Hollingsworth
Reg. No. 38,491